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ExxonMobil Research and Engineering Company
P.O. Box 900
1545 Route 22 East
Annandale, NJ 08801-0900

In re Application of:
Chang Samuel Hsu et al.
Serial No.: 09/521,072
Filed: March 7, 2000
Attorney Docket No.: LAW908

DECISION ON PETITION
TO WITHDRAW HOLDING
OF ABANDONMENT

This is a decision on the petition under 37 C.F.R. § 1.181, filed June 11, 2002, to withdraw the holding of abandonment of the above-identified application.

The petition is DISMISSED.

A non-final Office action was mailed October 3, 2001, setting a shortened statutory period of three (3) months to file a response thereto. Extensions of this period were available under 37 C.F.R. § 1.136(a). To date, no response has been received.

Petitioner states that the Office action was never received by applicant's representative and attests to the fact that a search of the file jacket and docket records indicates that "no Office Action has been received." The petition also includes "a copy of our docket record for all actions handled by this office for between October 3, 2001 and January 3, 2002. Also submitted was a Change of Address that was indicated to be effective immediately. Petitioner requests that any holding of abandonment be withdrawn based on petitioner's failure to receive the Office action.

A review of the written record indicates that a Notice to File Missing Parts of Nonprovisional Application was mailed on May 8, 2000, to ExxonMobil Research and Engineering Company, P.O. Box 390, Florham Park, NJ 07932-0390. In response thereto, a declaration and fees were submitted on July 5, 2000. The address listed in the response is ExxonMobil Research and Engineering Company, P.O. Box 900, Annandale, New Jersey 08801-0900; this address is different from the correspondence address of record at the time the non-final Office action was mailed and is the address now being listed on the Change of Address. Since a change of address was not requested, the Office action was mailed to the P.O. Box 390, Annandale, NJ address, which was of record at that time.

The written record indicates no irregularity in the mailing of the Notice of Allowance, and, in the absence of any irregularity, there is a strong presumption that the Notice of Allowance was properly mailed to petitioner at the address of record. This presumption may be overcome by a showing that the Notice of Allowance was not in fact received. The showing required to establish the failure to receive an Office action must include a statement from the practitioner stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c).

Pursuant to M.P.E.P. § 711.03(c), it is petitioner's burden to demonstrate that the Notice of Allowance was not in fact received at the correspondence address of record at the time it was mailed. The evidence of record appears to indicate that copy of the docket record is for all actions handled by petitioner's office at the P.O. Box 900, Annandale address and not at the P.O. Box 390, Florham Park address. Petitioner must establish that the Office action was not received at the P.O. Box 390, Florham Park address where the Office action was duly mailed. To this extent, the showing of record may have established only that petitioner did not receive the Office action but does not establish that it was not received at the P.O. Box 390, Florham Park, New Jersey address.


Further, the submission of a copy of Applicant's "docket record for all actions handled by this office between October 3, 2001 and January 3, 2002" to show "that no reply was docketed for this application" does not satisfy the requirement that a copy of the docket record where the non-received Office action would have been entered had it been received and docketed be submitted and referenced in petitioner's statement as set forth in M.P.E.P. § 711.03(c). A review of the copy of the docket record reveals that the record is for applications with a fatal due date ("Due/Fatal Date") ranging between October 3, 2001 and January 3, 2002. Absent any clear explanation by petitioner about the information listed in the docket record, it is reasonable to presume that the Due/Fatal Date is the date when the maximum statutory period for response within the meaning of 35 USC 133 expires. Since the Office action at issue was mailed on October 3, 2001, the fatal due date for the instant application would be logged in as 04/03/02 had the Office action been received by petitioner. Accordingly, petitioner has not made the requisite showing required under M.P.E.P. § 711.03(c), the holding of abandonment is proper.

The evidence of record indicates that the application may have become abandoned for failure to properly notify the Patent and Trademark Office of a change of correspondence address. As such, the petitioner may wish to consider filing a petition to the Director under 37 C.F.R. § 1.137 requesting that the application be revived.

A copy of the Office action mailed October 3, 2001 is enclosed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision.

Questions regarding this decision should be directed to Hien H. Phan, T-QAS, at (571) 272-1606.



Janice A. Falcone, Director

Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

enclosure: Copy of the non-final Office action of October 3, 2001.